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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,143

07/25/2003

Mark S. Spector

N.C. 84,766

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EXAMINER

HANLEY, SUSAN MARIE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

03/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/627,143	<b>Applicant(s)</b> SPECTOR ET AL.	
	<b>Examiner</b> SUSAN HANLEY	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-37 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The amendment and remarks filed 1/15/09 are acknowledged.

#### ***Election/Restrictions***

Claims 1-37 are pending.

Applicant's election of Group II, claims 27-33, the hydrogel specie of claim 18 and a protein as the analyte in the reply filed on 4/20/06 without traverse is again acknowledged. It is noted that the correct status of claim 32 is "previously presented" and the claim is under examination. Claims 28 and 29 are rejoined. New claims 34-37 will be examined.

Claims 1-26 stand withdrawn.

Claims 27-37 are under examination.

#### ***Withdrawal of Rejections***

The rejections not explicitly restated below are withdrawn due to Applicant's response in the amendment filed 1/15/09.

#### ***Claim Objections***

Claim 27 is objected to because they include reference characters which are not enclosed within parentheses.

#### ***Claim Rejections - 35 USC § 112***

Claim 30 now recites "an interpenetrating network and has an average pore size of about 0.1 to 10 microns". The specification does not disclose or describe an "interpenetrating network". Hence, this limitation remains NEW MATTER and the claim stands rejected and the New matter rejection stands over this limitation.

Claim 31 recites "a mechanically strong IPN structure and wherein the elastic modulus is in the range of from about 4.0 to about 10.3 Mpa". The specification, as filed, neither discloses nor describes, 1) a mechanically strong IPN (assuming that IPN means interpenetrating network); 2) IPN structure; 3) an elastic modulus; and 4) the range of from about 4.0 to about 10.3 Mpa." Hence, this limitation remains NEW MATTER and the claim stands rejected..

Applicant argues that the limitations of claims 30 and 31 that are regarded as New Matter represent inherent features that further narrow the scope of an allowable claim.

Applicant's arguments have been considered but are non-persuasive. Claim 27 is not allowable for the reasons stated below. Even it is was, the allowability of an independent claim does not automatically make a dependent claim allowable. Every claim is examined on its own merits. Regarding Applicant's assertion that the properties are inherent, the argument is an allegation without factual support and, therefore, non-persuasive.

Claims 27-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is rejected because the phrase "said glass plate" lacks antecedent basis in the claim.

Claims 33 and 37 are rejected because "commonly" is a relative term and no comparison is given.

Part C of claim 27 now recites: “ reacting said biomolecule to be assayed with said crosslinker and said hydrogel thereby forming a covalent bond between said biomolecule and said crosslinker and a covalent bond between said crosslinker and said hydrogel”. The second part of the claim that recites the order of bonding of the biomolecule, crosslinker and hydrogel appear consistent with the specification. However, this crosslinker is not the crosslinker that is part of the hydrogel of part A of the claim . Rather is a second crosslinker not "said crosslinker".

Claims 30-32 and 34-37 are dependent claims that do not overcome the deficiencies of the independent claim that they are dependent therefrom.

### ***Double Patenting***

Applicant is advised that should claims 32 and 33 be found allowable, claims 36 and 37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27-37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27 and 30-34 of copending Application No. 11444819. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '819 are a specie of the instant claims and therefore anticipate the cited claims. That is, claim 27 of '819 is drawn to the same method for assaying biomolecules and the claim names a specific biomolecule (DNA) that is assayed. The dependent claims also name SEB as a biomolecule and the same types of assays (fluorescence, etc.).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra Saucier/  
Primary Examiner, Art Unit 1651

/Susan Hanley/  
Examiner, Art Unit 1651

**Search Notes (continued)**

Application/Control No.

10/627,143

Examiner

SUSAN HANLEY

Applicant(s)/Patent under  
Reexamination

SPECTOR ET AL.

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1651

**SEARCHED**

Class	Subclass	Date	Examiner

**INTERFERENCE SEARCHED**

Class	Subclass	Date	Examiner

**SEARCH NOTES  
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
WEST: USPAT, EPAB, JPAB, DWPI, PGPUBS, updated	3/22/2009	SMH